

REMARKS

The issues outstanding in the instant application are as follows:

- The drawings stand objected to for informalities.
- Claims 1-34 are rejected under 35 U.S.C. § 103(a).

Applicant hereby traverses the outstanding rejection, and requests reconsideration and withdrawal in light of the remarks contained herein. Claims 1-34 are pending in this application.

Objection to the Drawings

The Draftsperson has objected to the drawings as described on form PTO 948 provided to Applicant with the Office Action dated August 29, 2000. Applicant requests that such objections be held in abeyance as provided by 37 C.F.R. § 1.111. Applicant proposes submitting formal drawings redressing the objections upon notice of allowance as provided by M.P.E.P. § 608.02(b).

Rejection under 35 U.S.C. § 103(a)

Claims 1-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Choquier et al. ('668, hereinafter Choquier) in view of Pearson ('754).

The prior arguments, with respect to the Examiner's prima facia case of obviousness, submitted by Applicant in the Amendment filed November 17, 2000, are believed to still be applicable to the above rejection of record and are, accordingly, incorporated herein. However, for the sake of brevity, those arguments will not be repeated herein. Applicant respectfully requests that the Examiner reconsider Applicant's previous arguments, with respect to insufficient motivation to combine the references and not all claimed elements being taught by the combination of references, in combination with the comments set forth below.

With regards to Applicant's arguments of insufficiency of the provided motivation to combine the cited references, the Examiner has responded in the Final Office Action by stating that the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner then states that the invention of Pearson complements the invention of Choquier use [sic] of layers

within a protocol stack within a computer. The invention of Pearson has a [sic] more insight to some of the layers to strengthen the teaching of Choquier. The Examiner then concludes by stating that the combination of Choquier and Pearson gives the user easier [sic] understand (replication) of the layers within a stack.

In response, Applicant notes that it is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. The language provided by the Examiner are merely statements that the references can be combined, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. For example, the statements that Pearson complements the invention of Choquier is a statement that the references can be combined. Similarly, the statement that the invention of Pearson provides more insight into the layers is also a statement that the references can be combined. The last statement, namely the combination of Choquier and Pearson gives the user easier [sic] understand (replication) of the layers within a stack, appears to be a conclusion that lacks supporting analysis and/or reasoning, as well as factual evidence from the references. Thus, the motivation and commentary provided by the Examiner is improper, as the motivation must establish the desirability for making the modification. Since no valid suggestion has been made as to why a combination of Choquier and Pearson is desirable, then the rejection of claims 1-34 should be withdrawn.

With regards to Applicant's arguments that the recited combination does not teach or suggest all claimed limitations, the Examiner has responded in the Final Office Action by stating that the claims must be given their broadest reasonable interpretation. The Examiner then states that Choquier discloses the limitations through the protocol stacks of the client and the server, and that the passages given [sic] to show the interaction of the layers within the client also had citations of the gateway involved with the transactions between the client and server. The Examiner concludes by stating that the client in the invention of Choquire was selected to read upon the Applicant's claimed invention, given their broadest reasonable interpretation.

In response, Applicant notes that giving the claims their broadest reasonable interpretation does not allow for limitations to be ignored. Applicant respectfully reminds the Examiner that "[a]ll words in a claim must be considered in judging the patentability of that

claim against the prior art," see M.P.E.P. § 2143.03, and that it is the claimed invention as a whole which must be considered when applying 35 U.S.C. § 103, see M.P.E.P. § 2141. The claims of the present invention require that the protocol stack comprises the plurality of protocol layers and the interfaces of the communication subsystem controller. The sections of Choquier being relied upon in the Office Action as teaching these elements are not in the same stack, in fact the elements are scattered between three different stacks located in computers, i.e. the client 102, the gateway 126, and the server 120. More specifically, the sections define elements 502a, 502b, 519, 520, 208a, and 208b, all of FIGURE 5A. If the Examiner is reading different elements of Choquier as teaching the limitations of the claimed invention, the Examiner must clearly explain his/her reading of the references. 'Whenever, on examination, any claim for a patent is rejected , or any objection . . . made', notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given," M.P.E.P. § 707. Furthermore, the Examiner must "clearly articulate[d] any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity," M.P.E.P. § 706. As the rejection currently stands, Choquier does not teach these claimed limitations and Pearson is not relied upon as teaching these claimed limitations. Therefore, Applicant respectfully asserts that for the above reasons claims 1-34 patentable over the 35 U.S.C. § 103(a) rejection of record.

CONCLUSION

For all the reasons given above, Applicant submits that the pending claims distinguish over the prior art of record under 35 U.S.C. § 103. Accordingly, Applicant submits that this application is in full condition for allowance.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

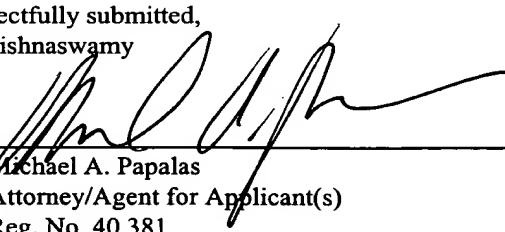
Date of Deposit: April 12, 2001

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